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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------|-------------|----------------------|---------------------|------------------|
| 10/615,585        | 07/07/2003  | Michiaki Otani       | 9333/352            | 8983             |
| 74989             | 7590        | 03/05/2008           | EXAMINER            |                  |
| ALPINE/BHGL       |             |                      | KNEPPER, DAVID D    |                  |
| P.O. Box 10395    |             |                      |                     |                  |
| Chicago, IL 60610 |             |                      |                     |                  |
|                   |             |                      | ART UNIT            | PAPER NUMBER     |
|                   |             |                      | 2626                |                  |
|                   |             |                      | MAIL DATE           | DELIVERY MODE    |
|                   |             |                      | 03/05/2008          | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|   |                  |                 |  |
|---|------------------|-----------------|--|
| <div style="border: 1px solid black; width: 150px; height: 20px; margin-bottom: 5px;"></div> <b>Office Action Summary</b> | Application No.  | Applicant(s)    |  |
|   | 10/615,585       | OTANI, MICHIAKI |  |
|   | Examiner         | Art Unit        |  |
|   | David D. Knepper | 2626            |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br/>           Paper No(s)/Mail Date _____</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>           Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|---|---|

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1. Applicant's correspondence filed on 26 November 2007 has been received and considered. Claims 1-18 are pending.

### Claims

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6 and 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Renegar (6,024,571).

Applicant is referred to the rejection of 21 Sep 2007 in its entirety to include the Response to arguments which clarified terminology such as “translation” which is used extensively by the applicant and has a widely accepted and unambiguous meaning in the English language as pertains to converting from one language to another.

The applicant is also referred to the Interview Summary of 29 October 2007 which indicates that the discussion focused on the term “transliteration” which is not used by the applicant but is apparently what the applicant intended to claim. The record shows that the applicant is claiming translation which has a clear and unambiguous meaning which differs from what the applicant intends to claim. As is shown by the prior art, various forms of translation are well-known which render the claimed subject matter unpatentable.

While the applicant argues that they are changing the claims based on a suggestion by the Examiners, the record shows that, to the contrary, the Examiners believe the claims are not

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directed to transliteration. No suggestion from the Examiners is of record and, therefore, the applicant's statement appears to be misleading.

It is unclear whether it is possible for the applicant to claim transliteration using terminology that does not encompass or describe this concept. As the previous Office Action describes, the claim term "character or string" will inherently include not only one or more characters but also one or more words. That such terminology includes a host of different meanings is clearly expressed in the way various claims are rejected. See for example, claim 16, (page 6 of the Office Action) where the claimed text includes a host of database items to include streets, roads, destination, landmarks, etc.; column 13, lines 52-67.

The applicant makes general reference to responses on 10 September 2007 and 22 June 2007. However, these arguments were previously addressed and fail to explain how they follow any suggestions that are pertinent to the Interview of 29 Oct 2007. To the contrary, various claims such as claim 16 which requires the invention to include concepts such as navigation is not limited to particular text elements but include one or more words. Such concepts require one or more words with multiple meanings and appear to be very relevant to translation systems such as the prior art applied. Therefore, it would appear that the changes to the claims do not limit the claims to the transliteration concept discussed during the interview.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-10 are rejected under 35 U.S.C. § 103 as being unpatentable over Renegar in view of Conkie (6,173,263).

Applicant is referred to the rejection of 21 Sep 2007 in its entirety to include the Response to arguments which clarified terminology such as “translation” which is used extensively by the applicant and has a widely accepted and unambiguous meaning in the English language as pertains to converting from one language to another.

Similar to the above discussion, the claimed “replacing the abbreviated original text item with a full text item” would require understanding or interpretation of the meaning of abbreviations and/or word description thereof. Thus, it would appear that the prior art which performs translation of abbreviated text is clearly pertinent and that the claims do not overcome the prior art rejection.

#### **Response to Arguments**

6. The above rejections include explanations in response to the arguments presented by the applicant on 26 Nov 2007. The remarks that Renegar does not teach “replacing the identified character/string with a character/string in the alphabet of the second language having an equivalent or similar pronunciation” is not true because some words in different languages are similar in spelling and/or pronunciation and this has been shown with some examples.

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Translation inherently requires consideration of the meaning (of words) because failing to consider the meaning could result in erroneous translation. A good example in Spanish could include the word --papa-- (stress first syllable and it means “potato”) versus --papa’-- (stress second syllable and it means “father” = English “papa”).

The claims are not directed towards transliteration but are instead directed towards forms of translation which are taught by the prior art. The specification appears to use the term translation in support of the interpretation given the claims throughout prosecution. This suggests that the claims have been correctly interpreted in view of the specification as a whole. There does not appear to be support in the instant application for transliteration because this term does not appear in the claims, specification or drawings. Although the interview seems to place emphasis on the term transliteration as the focus of what the applicant has invented, the applicant has not claimed or argued any effective distinction showing that this is in fact the intended claim interpretation or that such an interpretation is supported by the specification.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Some correspondence may be submitted electronically. See the Office's Internet Web site <http://www.uspto.gov> for additional information.

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**The Central fax number is 571-273-8300.** Please label INFORMAL" or "DRAFT" communications accordingly.

Mail Stop should be omitted if none is indicated.

Effective 14 January 2005, except correspondence for Maintenance Fees, Deposit Accounts (see 37 CFR 1.25(c)(4)), and Licensing and Review )see 37 CFR 5.1(c) and 5.2(c)), please address correspondence delivered by other delivery services (i.e. – Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

U.S. Patent and Trademark Office  
Customer Window, Mail Stop \_\_\_\_\_  
Randolph Building  
Alexandria, VA 22314


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Knepper whose telephone number is (571) 272-7607. The examiner can normally be reached on Monday-Friday from 9:00 a.m.-6:30 p.m., second Friday off with 2<sup>nd</sup> Thursday hours of 8:00 a.m.-4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth, can be reached on (571) 272-7843.

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For the Group 2600 receptionist or customer service call (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by email at [ebc@uspto.gov](mailto:ebc@uspto.gov). For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

A handwritten signature in black ink, appearing to read "David D. Knepper", is positioned above the printed name.

David D. Knepper  
Primary Examiner  
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